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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,295	07/31/2003	Jeffrey H. Wood	BO1-0259US	3327

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LEE & HAYES, PLLC
421 W. RIVERSIDE AVE.
SUITE 500
SPOKANE, WA 99201

EXAMINER

LE, TAN

ART UNIT	PAPER NUMBER
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3632

MAIL DATE	DELIVERY MODE
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05/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,295	Applicant(s) WOOD ET AL.	
	Examiner Tan Le	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5-11, 13-26 and 28-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 12, 27 and 44-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's reply filed 2/27/07 is acknowledged. Currently claims 1-47 are pending. Claims 3, 5-11, 13-26 and 28-43 were previously withdrawn. Claims 44-47 have been added and considered readable to the elected species of Figures 4-5.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 45 and 47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, claims 45 and 47, each recites, "a plurality of *non-apertured dimples* configured to be mate to *an adhesive layer* formed on the support structure" (lines 2-3). The negative limitation, e.g., "non-apertured dimples configured to be mate to an adhesive layer formed on the support structure" in claims 45 and 47 does not have basis in the original disclosure. Thus, this is new matter. See MPEP 2173.05(i) and the legal precedents cited in the article "*The Introduction of Negative Claim Limitations During Ex Parte Prosecution: 35 USC 112 and the Issue of Antecedent Support*" of

Steven J. Hulquist in *Journal of the Patent & Trademark Office Society*, March 1991, Volume 73, No. 3, page 218.

The above negative limitation recited in the claims 45 and 47 also did not appear in the specification as original filed, thus introduces new concepts. *Ex parte Grasselli*, 231 USPQ 393 (Bd. Pat. App. & Inter. 1986) and *Ex parte Pearson*, 239 USPQ 711 (Bd. Pat. App. & Inter. 1985).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, 12, 27, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent no. 6,195,811 to Dragovic.

As to claims 1-2 and 27, Dragovic teaches a bracket (see Fig. 2-7) substantially as claimed which comprises a first portion (21); a second portion (23) configured to adhere to a support structure, the second portion extending outwardly from the first portion to form an enclosed angle therebetween, the second portion having an inner surface adjacent to the enclosed angle and an outer surface opposite from the inner surface, wherein a second portion includes a plurality of separation features (25, 27) (Fig. 3), the separation features projecting inwardly from the inner surface, the separation features including at least one of dimples and ridges (see attached Figure

6), configured to separate the second portion from the support structure by a predetermined amount, wherein the plurality of separation features maintains separation by a predetermined amount. Dragovic also teaches an adhesive (37) for adhering between the second portion and the support structure, the size of plurality of separations features is inherently based on an amount of adhesive (37).

Dragovic teaches substantially as claimed except for the plurality of separation features projecting outwardly from the outer surface of the second portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of separation features projecting outwardly from the outer surface, since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art and the intended use of the device to be attached. In re Einstein 8, USPQ 167.

As to claims 4 and 12, Dragovic also teaches the plurality of separation feature including a plurality of dimples (see Fig. 6) and the bracket can be either formed by one of molding or extruding (see Col. 2, 25-29). Note that the recitations such as "the process of adhering the second portion to the support structure (claim 1, lines 13-14) or the recitation "formed by one of molding or extruding" (claim 12; lines 1-2) are method limitations in the article claims. The method of forming or processing is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

As to claims 44 and 46, the provision of calling the plurality of dimples distributed in a non-linear arrangement on the outer surface of the second portion would have been

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no more than an obvious matter of design choice since there are no additional teaching or criticalities from Applicant regarding the nonlinear arrangement. This would have led a person of ordinary skill in the art to have had a reasonable expectation that any dimples can be used and distributed at any desired locations along the second portion.

In addition, the nonlinear arrangement of the dimples as claimed would have been a matter of design choice in design since the claimed structure and the function they perform are the same as prior art (functionally equivalent).

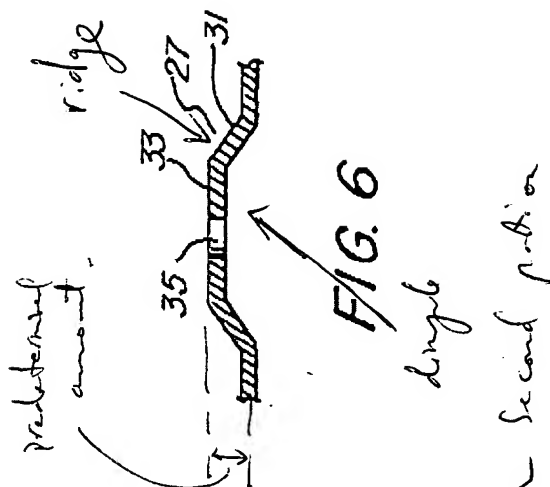
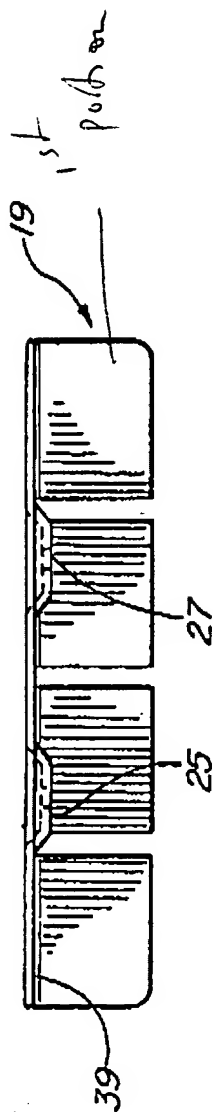


FIG. 4

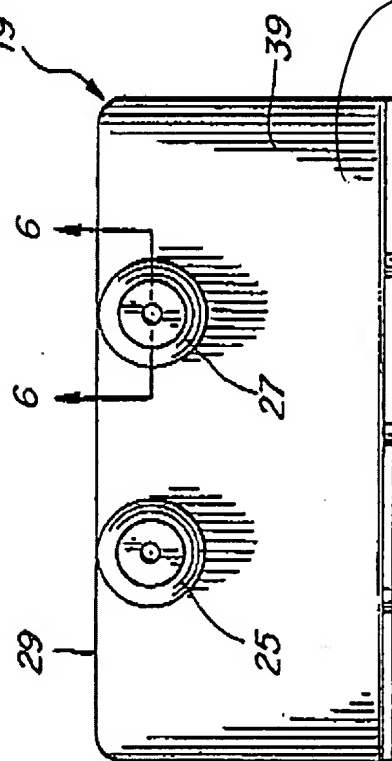


FIG. 5

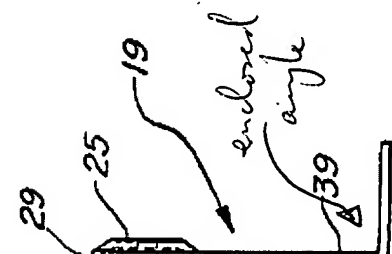


FIG. 3

Response to Arguments

Applicant's arguments filed 2/27/07 have been fully considered but they are not persuasive.

Applicant's remarks regarding that the adhesive (and/or support structure) is not claimed as indicated on page 12, 3rd paragraph of the Remarks) has been noted and thus the claim objection in the previous office is withdrawn.

Applicant, however, argued "Dragovic fails to provide dimples and/or ridges that are configured to separate a second portion from *a support structure by a predetermined amount*. Also, Dragovic fails to provide that a plurality of separation features that maintain separation by *a predefined amount throughout a process of adhering a second portion to a support structure*. Furthermore, Dragovic fails to provide *the size of the plurality of separation features is based on an amount of adhesive used in the process of adhering a second portion to a support structure*" (page 13, 3rd paragraph). The examiner respectfully disagrees for the reasons as follows:

(a) Applicant's arguments relied on the limitations that are not claimed as admitted by Applicant; (b) since the adhesive and the support structure are basically not claimed and not defined in the claims, any argument relates to "adhesive", "by a predetermined amount", or "the size of the plurality of separation features is based on an amount of adhesive used in the process of adhering a second portion to a support structure" is considered irrelevant and therefore have not been given weight.

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Applicant's argument that Dragovic fails to teach "...by a process of adhering a second portion to a support structure" or "formed by one of molding or extruding" is also not persuasive for the same reason as mentioned above and further it has not given weighted because this is a method limitation in the article claims. The method of adhering is not germane to the issue of patentability of the device itself as pointed out in the office action.

In summary, Applicant's arguments with respect to Dragovic on pages 12-16 of the Remarks are not persuasive. Dragovic clearly teaches all the structural limitations as pointed out in the office action.

New added claims 44 and 46 further recites "the plurality of dimples that are distributed in a non-linear arrangement on the outer surface of the second portion", however, this limitation has also been rejected in view of the reasons as discussed in the office action.

Newly added claims 45, 47 recites the limitations of "non-apertured dimples configured to be mated to an adhesive layer formed in the support structure", which introduces new matter and new concepts, which has also discussed in the office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (571) 272-6818.

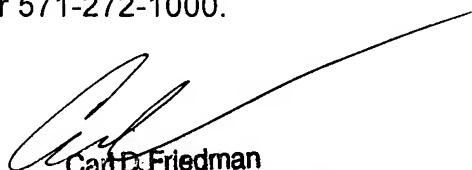
The examiner can normally be reached on Mon. through Fri. from 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tan Le
May 1, 2007.



Carl D. Friedman
Supervisory Patent Examiner
Group 3600